

### Remarks

The Office Action mailed February 25, 2008 has been carefully reviewed and the following amendment is submitted in consequence thereof.

Applicant believes that no extension of term is required and that no additional fee for claims is required. If any additional fee is required for an extension of term or claims, the Commissioner is hereby authorized to charge Deposit Account No. 01-2384.

Claims 1-7 and 9-29 are now pending in this application, of which claims 1 and 9 have been amended. It is respectfully submitted that the pending claims define allowable subject matter.

Applicants will now respond to the issues noted in the Office Action in the order set forth therein.

#### I. The § 112 Rejections

The rejections of claims 1-7 and 9-29 under 35 U.S.C. § 112, ¶ 2 is respectfully traversed.

The Office Action states the following on page 2:

Besides not having any structure to pivot on at least two axes it is noted that no connection has been set forth between the pole and luggage. Even though the handle is connected to the pole it is set forth as an isolated element and without any orientation to the wheels to permit the handle to assume the position in the retracted state as it is being claimed.

Notably, the rejection does not state that the claims are ambiguous, unclear, or not amenable to reasonable interpretation. Rather, the rejection appears to reflect a preference of specific structure to be recited in the claims. MPEP § 2173.02 cautions the Office that an examiner should not reject claims or insist on their own preferences if the statutory requirements are otherwise met. Nowhere does § 112 require recital of structure in the manner suggested in the Office Action. Indeed, MPEP § 2173.04 notes that if the enabling disclosure of the specification is not commensurate with the scope of the claim, that fact does not render the claim

imprecise or indefinite or otherwise noncompliant with § 112 ¶ 2. Applicants need not, therefore, recite in the claims specific structure disclosed in the specification to satisfy § 112 ¶ 2. Applicants are free to draft claims having a scope that is not necessarily limited to the particular embodiments disclosed, and as long as they do with sufficient particularity and clarity, the Office should not object unless other requirements of patentability are not met.

Applicants again refer to the Office Examination Policy regarding rejections under Section 112 that, consistent with the applicable law, notes that the essential question under § 112 ¶ 2 is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. If the scope of the invention sought to be patented cannot be determined from the language of the claims, a § 112 ¶ 2 rejection is appropriate. Such rejections are inappropriate, however, when the disclosure and claims are sufficient for one skilled in the art to understand. The present claims are submitted to be clear, precise and particular in their scope, which is all that § 112 ¶ 2 requires. As the Federal Circuit has recently noted, indefiniteness will only be an issue if the functional language in a claim fails to provide a clear-cut indication of the scope of subject matter embraced by a claim. Microprocessor Enhancement Corp. v. Texas Instruments, Inc., Fed. Cir., No. 2007-1249, April 1, 2008. This is certainly not the case here.

It is also clear from MPEP § 2173.04 that breadth of claim does not render it indefinite, and if the scope of a claim is clear (metes and bounds) then it complies with § 112 ¶ 2. MPEP § 2173.05(g) also states that functional language does not, in itself, render claim language indefinite. That is, a functional limitation must be evaluated and considered, just like any other limitation of the claim – for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. The scope of the present claims, including structure and functional aspects thereof, are submitted to be readily ascertainable and understood by those in the pertinent art. Consequently, claims 1-7 and 9-29 are submitted to meet the requirements of § 112 ¶ 2.

Applicants accordingly request that the rejection of the claims under § 112 ¶ 2 be reconsidered and withdrawn.

## II. The Section 103 Rejections

The pending claims stand rejected as obvious over one or more combinations of the Lu '055, Lu '053, Cheng '146, Chang '662 and the Lin et al. '089 references. The rejections are considered below after some preliminary remarks.

### A. The Lu Reference and the 1.132 Declaration of Record

On page 3, paragraph 5, of the Office Action it is asserted that the declaration under 37 C.F.R. § 1.132 is ineffective to overcome the “Lu reference.” Applicants once again note that multiple “Lu” references are of record in the present prosecution and it should be made clear which Lu reference is being addressed. The Declaration concerns the Lu'044 Patent reference. The Office Action states that the declaration is ineffective because Applicants have failed to establish a nexus between the current claims and the evidence submitted.

Applicants respectfully submit that Applicants are not required to establish a nexus between the current claims and the disclosure of Lu to disqualify the reference under 37 C.F.R. § 1.132. The Office is invited to consider In re DeBaun, 214 USPQ 933 (CCPA 1982) that is cited in MPEP § 716.10. A copy of In re DeBaun and MPEP § 716.10 are attached for the Examiner's convenience. In re DeBaun held that is legal error to focus on the invention being claimed by the Applicants in evaluating the 1.132 declaration of the type at issue here.

As noted in In re DeBaun, when faced with a 1.132 Declaration of the type at issue here, the proper subject of inquiry is what the evidence shows regarding *who* invented the subject matter disclosed by the reference relied upon to support the rejection. The Applicants must provide satisfactory evidence, in light of the total circumstances of the case, that the reference reflects their own work. The court in In re DeBaun found that an Applicant's unequivocal declaration that he conceived of anything in the reference relied upon to support the rejection that would suggest his invention claimed in his application was satisfactory evidence to remove the reference relied upon as prior art and overcome the rejection.

MPEP § 716.10, consistently with In re DeBaun, states that a statement that the Applicants invented the subject matter disclosed in a patent may be insufficient when there is

evidence to the contrary, but this clearly does not apply to the present prosecution. The Office has not provided, nor has it been provided with, any evidence to contradict, or even reasonably call into question, the unequivocal statement in the 1.132 Declaration that the Lu reference is a description of Applicants own prior work. Applicants therefore request that, pursuant to the provisions of M.P.E.P § 716.10, that the Office does accept the 1.132 declaration.

B. The Section 103 Rejections Asserted

The Section 103 rejections will now be considered in the order set forth in the Office Action.

1. Lu '055 and Lu '053 in view of Chang '146 or Chang '662

The rejection of claims 1-7 and 9-29 under 35 U.S.C. § 103(a) as being unpatentable over Lu '055 and Lu '053 in view of Chang '146 or Chang '662 is respectfully traversed.

As a matter of procedure, the Chang '662 reference was filed after the priority date of the present application and is not prior art vis-à-vis the present application. Thus, Applicants submit that the rejection is procedurally improper to the extent that it relies upon Chang '662 and should be withdrawn. Cheng '662 was filed as a continuation-in-part application of the Cheng '146 application, but because the present application claims priority to a date prior to the filing date of the Chang '662 application, any new matter introduced in the Cheng '662 reference that is not found in the Chang '146 application is not entitled to the filing date of the Cheng '146 application and cannot be cited against the presently claimed subject matter.

Applicants wish to note each of the Lu '053 and Lu '055 patent application publications relied upon by the Office in the instant rejection list the same inventor as the Lu '344 Patent. The applications corresponding to the Lu '053 and Lu '055 publications were filed on December 31, 2002, less than three months prior to the priority date of the present application on March 7, 2003. This is not believed to be coincidental. Upon information and belief, the circumstances explained in the 1.132 Declaration also apply to the Lu '055 and '053 references, such that the Lu '055 and Lu '053 references also are descriptions of prior work of the present Applicants that was communicated to Mr. Lu in the course of business relationships wherein Mr Lu was

proposing to manufacture products on behalf of the present assignee. That is, Applicants do not believe that the Lu '055 and '053 references are "prior art" to the presently claimed invention either because these references also are in essence descriptions of the Applicants own prior work. It is perhaps revealing that, as PTO PAIR records confirm, the Lu '055 application was rejected in light of other commonly owned patents of the present assignee

Notwithstanding the above, it is not presently believed to be necessary to disqualify the Lu '055 and Lu '053 references to overcome the present rejection based upon the Lu '055 Reference for the reasons explained below. Applicants reserve the right and the opportunity to submit evidence to disqualify Lu '055 and Lu '053 references as prior art if the Office persists in asserting these references against the claims.

The disclosures of the cited references fail to disclose or suggest all the recitations of the present claims and a *prima facie* case of obviousness is not believed to exist. The rejection appears to reflect an impermissible hindsight reconstruction of the invention now being claimed because the rejection appears to infer conclusions of obviousness despite gaps in the teaching of the references concerning the subject matter claimed.

Independent claims 1, 9, 28 and 29 all recite, among other things, a towing handle having a grip with a principal dimension and in the retracted position, the grip portion is arranged so that the principal dimension is generally perpendicular to the wheel rotation axis. The Lu'055 and '053 references nowhere disclose or suggest such a feature.

Neither Lu '055 nor Lu '053 describes the handle section (1) in a retracted position at all. Lu'053 discloses in Figures 3 and 5 a cross section showing the handle section, control section, and adjusting section "before depressed." See Lu '053 paragraphs [0010] and [0012]. It is clear that "before depressed" refers to depressing of the pushbutton (14). See Lu '053 paragraphs [0016], [0022] and [0023]. Lu '055 includes similar description in relation to Figure 5 and 7 and paragraphs [0016], [0018] and [0027]. Both the Lu' 055 and '053 references, however, are simply silent regarding any retracted position of the handle. Rather, the Lu '055 and '053 references simply disclose exemplary handle orientations before and after actuation with a pushbutton. This does not, on its own, implicate any conclusion regarding the position of the

handle in the retracted position. It is clear that multiple before and after positions are possible to reorient the handle by depressing the push button.

As a result, the assertion in the Office Action that members (212) permit the Lu '055 and '053 handles to assume the perpendicular relationship with the wheel axis is true, but insignificant vis-à-vis the presently claimed subject matter. It is equally true that the members (212) also permit the handle section (1) to be positioned parallel to the wheel axis. Applicants refer the Office to Lu '053 that in Figure 7 discloses a handle positioned 90 degrees from a perpendicular orientation to the members (41) and (42) such that the handle section (1) is oriented generally parallel to the members (41) and (42). That the members (212) could position the handle in a perpendicular relationship is no more consequential than the members (212) could position the handle in a parallel relationship with the wheel axis. The Lu '055 and '053 references are at best ambiguous regarding any preferred orientation of the handle section when the handle is retracted.

Applicants again point out that in the Lu '344 Patent of record, a handle construction is disclosed that is not unlike the conventional handle structures discussed in the present specification in paragraphs 10-13, for example, in that the handle is oriented parallel to the wheel axis when retracted. That is, the Lu '344 patent and the Lu '055 and '053 references of the same inventor are believed to typify a common, and conventional handle configuration at least as far as the orientation of the handle in the retracted position is concerned. Consequently, Lu '055 and '053 are not suggestive in any way that any other orientation of the handle is or would be desirable.

Chang '146 is cited for teaching a recess in the top face to secure the pivoting handle with the major dimension oriented perpendicular to the rear face and the axis of the wheels. Applicants traverse this view of the Chang '146 reference. The written disclosure of Chang '146, which is difficult to follow, provides no textual support for the position taken by the Office. The features (12) and (13) that the Office appears to rely upon in the Chang '146 figures (e.g., Figure 2) are not described in the Chang '146 written description. Thus, the Chang '146 reference is at least ambiguous regarding these features, and it appears somewhat

speculative to draw conclusions regarding the function and purpose of the features (12) and (13) in the Chang '146 figures when those features are not described.

The rejection appears to be based on an impermissible hindsight reconstruction of the invention rather than based on any contextual reading of the references asserted. In KSR, the Supreme Court cautioned that obviousness conclusions should not rely on *ex post* reasoning. Temptations to read the teaching of an invention into the prior art, and to view the prior art with hindsight in light of the teaching of an invention, should be resisted. That is, the teachings of a patent disclosure should not affect the hypothetical analysis of what a person of ordinary skill, without having the benefit of the patent disclosure, would have done at the time of the invention. Neither the cited art nor the present Office Action supplies any reason or analysis of what a person of ordinary skill, using common sense, would have done at the time the invention was made.

In any event, claim 1 now recites, among other things that in the retracted position, “said grip portion is arranged so said principal dimension is generally perpendicular to said wheel rotation axis and generally parallel to the top face.” Independent claim 9 recites, among other things, that the “grip portion is nested in said receptacle when in the retracted position in a generally coplanar relationship with a face of the piece of luggage.” Independent claims 28 and 29 each recite, among other recitations, that “in said retracted position, said grip portion is arranged so said principal dimension is generally perpendicular to said wheel axis and said principal dimension is generally parallel to said top face.” The axis of the handle as depicted in Figure 2 of Chang '146 does not meet these recitations. Rather, the axis of the handle is noticeably oblique relative to the top face (and other faces for that matter) and the axis of the wheels. Chang '146 does not disclose this feature, and neither do the Lu '055 and Lu '053 disclosures. Simply put, Lu '055 and Lu '053 are silent on this issue, and Chang '146 is distinguishable on this issue.

Finally, it is not clear that even if one were to make the combination suggested in the Office Action that the presently claimed invention would result. The Lu '055 and '053 handles apparently could be oriented in an oblique manner similar to Figure 2 of Chang '146 such that the claimed invention would not result even if the features (12) and (13) of Chang were utilized.

It is therefore respectfully submitted that Lu '055 and '053 in view of Cheng '146 does not present a *prima facie* case of obviousness for the present claims. The cited references simply fail to teach all the recitations presently being claimed in the pending independent and dependent claims.

For at least the reasons above, all the independent claims 1, 9, 28 and 29 are believed to be patentable over Lu '055 and '053 in view of Chang '146 or Cheng '162. The clarifying details recited in the independent claims are likewise not fairly disclosed or suggested by the cited art and are also submitted to be patentable.

Applicants accordingly request that the rejection of claims 1-7 and 9-29 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

2. Lin et al. '089 ' in view of Shafer '064 or Chang '146

The rejection of claims 1-6, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Lin et al. '109 ' in view of Chang '146 or Chang '662 is respectfully traversed.

As noted above, the Chang '662 reference was filed after the priority date of the present application and is not prior art vis-à-vis the present application. Thus, Applicants submit that the rejection is procedurally improper to the extent that it relies upon Chang '662 and should be withdrawn.

As also discussed above, Chang '146 is at best ambiguous regarding the features relied upon in the rejection because features (12) and (13) in the figures are not described. Additionally, the oblique orientation of the Chang '146 handle violates the recitations concerning in the retracted position, "said grip portion is arranged so said principal dimension is generally perpendicular to said wheel rotation axis and generally parallel to the top face" as claim 1 recites, and that "in said retracted position, said grip portion is arranged so said principal dimension is generally perpendicular to said wheel axis and said principal dimension is generally parallel to said top face" as independent claims 28 and 29 recite.



Lin et al. '089 does not cure the deficiencies of Chang '146. In fact, Lin et al. '089 directly teaches away from the subject matter now being claimed. Specifically, independent claims 1, 28 and 29 each recite that in the retracted position the grip portion is arranged so the principal dimension is generally perpendicular to the wheel rotation axis. Lin et al. '109 teach precisely the opposite at least in paragraph [0036] wherein the handle grip (20) is described as extending parallel to a straight line between the wheels in a normal unused position. Lin et al. '109 therefore stands in direct conflict with independent claims 1, 28 and 29 on this aspect and Lin '089 in view of Chang '146 does not present a *prima facie* case of obviousness for these independent claims or their associated dependent claims.

Applicants accordingly request that the rejection of claims 1-6, 28 and 29 as being unpatentable over Lin et al. '089 in view of Chang '146 or Cheng '662 be reconsidered and withdrawn.

### III. Conclusion

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (Expert described how he would construct elements necessary to the claimed invention whose construction was not described in the application or the prior art; this was not sufficient to demonstrate that such construction was well-known to those of ordinary skill in the art.); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. *In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944). But see *Glaser v. Strickland*, 220 USPQ 446 (Bd. Pat. Int. 1983) which reexamines the rationale on which *In re Oppenauer* was based in light of the Federal Rules of Evidence. The Board stated as a general proposition “Opinion testimony which merely purports to state that a claim or count, is ‘disclosed’ in an application involved in an interference . . . should not be given any weight. Opinion testimony which purports to state that a particular feature or limitation of a claim or count is disclosed in an application involved in an interference and which explains the underlying factual basis for the opinion may be helpful and can be admitted. The weight to which the latter testimony may be entitled must be evaluated strictly on a case-by-case basis.”

### 716.10 Attribution

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the

other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide “a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor” of the subject matter disclosed in the article and claimed in the application).

An uncontradicted “unequivocal statement” from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary. *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author’s inventorship); *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (dis-

claiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author, patentee, or applicant of the published application of a first reference does not enable an applicant to step into the shoes of that author, patentee, or applicant of the published application in regard to its date of publication so as to defeat a later second reference. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

## EXAMPLES

The following examples demonstrate the application of an attribution affidavit or declaration.

### Example 1

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

### Example 2

Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.

## 718 Affidavit or Declaration to Disqualify Commonly Owned Patent as Prior Art, 37 CFR 1.130 [R-6]

*37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.*

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S.

patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) [Reserved]

See MPEP § 804.03 and § 706.02(l) through § 706.02(l)(3) for subject matter disqualified as prior art under 35 U.S.C. 103(c) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

37 CFR 1.130(a) addresses those situations in which the rejection in an application or patent under reexamination to be overcome is a rejection under 35 U.S.C. 103 in view of a U.S. patent or U.S. patent application publication due to the requirement in 37 CFR 1.131 that any U.S. patent or U.S. patent application publication to be antedated not claim the same patentable invention (as defined in 37 CFR 41.203(a)) as the application or patent under reexamination. The applicant or patent owner is also prevented from proceeding in an interference due to the provision in 37 CFR 41.206 that an interference will not normally be declared or continued between applications that are commonly owned, or an application and an unexpired patent that are commonly owned.

As 37 CFR 1.130(a) addresses those situations in which the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent or patent application publication are not patentably distinct, 37 CFR 1.130(a)(1) requires a terminal disclaimer in accordance with 37 CFR 1.321(c), and 37 CFR 1.130(a)(2) requires an oath or declaration stating, *inter alia*, that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104. The inventor named in the application or patent under reexamination must have invented the claimed subject

**Results for:** CASECITE(214 uspq 933)

USPO, 1st Series (1929 - 1986) > U.S. Court of Customs and Patent Appeals > In re DeBaun, 214 USPQ 933 (C.C.P.A. 1982)

**214 USPQ 933**  
**In re DeBaun**  
**U.S. Court of Customs and Patent Appeals**

No. 82-530

Decided August 27, 1982

687 F2d 459

## Headnotes

### PATENT

**[1] Affidavits -- Anticipating references (Rule 131) (► 12.3)**

Declarations that fail to allege facts showing necessary diligence and/or reduction to practice of claimed invention are insufficient under Patent Rule 131.

**[2] Patentability -- Anticipation -- Patents -- In general (► 51.2211)**

Patent to applicant and another that issued less than one year before filing date of applicant's original patent application is only available as reference if pertinent disclosure is not applicant's sole work.

**[3] Patentability -- Anticipation -- Patents -- In general (► 51.2211)**

Proper subject of inquiry is what evidence showed as to who invented subject matter disclosed by reference relied on to support rejection and not whether declarations supported applicant's assertion of inventorship of presently claimed improvement.

**[4] Applicants for patent -- In general (► 14.1)**

Existence of combination claims does not evidence inventorship by patentee of individual elements or sub-combinations of them if latter are not separately claimed apart from combination; inventor of combination may not have invented any element much less each of elements.

**[5] Interference -- Conception of invention (► 41.10)**

**Interference -- Reduction to practice -- In general (► 41.751)**

Although completed invention requires both conception and reduction to practice, there is no requirement that inventor be one to reduce invention to practice so long as reduction to practice was done on his behalf.

### Particular Patents

**Particular patents -- Velocity Equalizer**

DeBaun, Fluid Velocity Equalizing Apparatus, rejection of claims 9 and 10 *reversed*.

### Case History and Disposition

Appeal from the Patent and Trademark Office Board of Appeals.

Application for patent of Kenneth W. DeBaun, Serial No. 952,695, to reissue Patent No. 3,964,519, filed Nov. 18, 1974. From decision rejecting claims 9 and 10, applicant appeals. Reversed; Miller, Judge, concurring with opinion.

### Attorneys

Ernest M. Anderson, San Francisco, Calif., for appellant.

Joseph F. Nakamura and Henry W. Tarring, II for Patent and Trademark Office.

### Judge

Before Markey, Chief Judge, and Rich, Baldwin, Miller, and Nies, Associate Judges.

## Opinion Text

### Opinion By:

Nies, Judge.

This appeal is from the decision of the Patent and Trademark Office (PTO) Board of Appeals (board) sustaining the rejection of claims 9 and 10 in application Serial No. 952,695 for reissue of Patent No. 3,964,519 filed November 18, 1974, for "Fluid Velocity Equalizing Apparatus." The rejection was for obviousness under 35 USC 103<sup>1</sup> in view of a disclosure in a patent issued to appellant and Noll less than one year prior to November 18, 1974. The board held that the reference may be used against appellant. We reverse.

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<sup>1</sup> 35 USC 103 provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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## Background

The invention "relates generally to apparatus for conditioning the flow pattern [of] fluids flowing in conduits \* \* particularly \* \* \* for equalizing the velocity profile of fluid flowing in a conduit." The invention is stated to be "useful in the type of apparatus

**Page 934**

disclosed in U.S. Patent 3,842,678 issued to Kenneth W. DeBaun and Robert W. Noll on October 22, 1974." The DeBaun and Noll patent ('678 patent) filed June 1, 1973, is the sole reference forming the basis of the examiner's rejection.

The claims of the present application are directed specifically to the "equalizer honeycomb section 4."<sup>2</sup> Claim 9 is representative.

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<sup>2</sup> The only drawing in appellant's application, shown below, is identical, except for numbering, to Fig. 6 of the '678 patent, and shows the equalizer honeycomb section 4 in an air duct 2. The duct is part of the air sampling system claimed in the '678 patent.

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA at 1-800-372-1033.*

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9. Apparatus for equalizing the velocity of flowing fluid including duct means defining a flowing stream of fluid; at least one open-ended honeycomb equalizing section substantially coaxial with said duct means, intercepting and conducting the fluid therethrough, said honeycomb section having a plurality of parallel passages across substantially the entire duct cross-section *wherein the ratio of surface area of each passage to the cross-sectional area of each passage is at least 30* and the end of the honeycomb facing the stream of fluid is curved to flatten the velocity profile of the stream. [Emphasis ours.]

The examiner rejected the claims under 35 USC 103 in view of the '678 patent. The '678 patent and the subject application disclose an identical passageway with an equalizer honeycomb section by the '678 patent neither describes nor claims the equalizer honeycomb section's ratio of surface area to cross-sectional area. Further, the reference claims a complete air sampling system including the passageway containing the basic equalizer honeycomb section as shown above while appellant claims only the passageway containing the improved equalizer honeycomb section.

Appellant concedes that the equalizer honeycomb section of the '678 patent is "essentially constructed in accordance with applicant's invention." He further concedes, for purposes of appeal, that the relationship of surface area to cross-sectional area is "part of the teaching of [the '678 patent] or would be obvious in view thereof."

To overcome the rejection, the examiner required that appellant file an affidavit under Rule 131<sup>3</sup> and an affidavit by Noll disclaiming inventorship of the basic equalizer honeycomb section.

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<sup>3</sup> Rule 131, 37 CFR 1.131 provides:

(a) When any claim of an application is rejected on reference to a domestic patent which

substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath or declaration as to facts showing *a completion of the invention* in this country before the filing date of the application on which the domestic patent issued, \* \* \* or before the date of the printed publication, then the patent or publication shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country, [Emphasis ours.]

No affidavit by Noll was submitted to comply with the examiner's requirement. Instead, appellant's attorney filed a declaration stating, inter alia, that "he is informed and believes" that Noll's whereabouts are not known to Air Monitor Corporation. <sup>4</sup> Noll was an employee of Air Monitor Corp. as the time the application for the '678 patent was filed but has since left its employ.

<sup>4</sup> Appellant's application is assigned to Air Monitor Corp. of which appellant is president. Apparently, appellant's attorney has formed his "belief" on information gained solely from discussion with appellant. Appellant has filed to indicate why he did not simply include the information in his own declaration. Since we hold that Noll's disclaimer is unnecessary, we need not evaluate the weight to be given to the attorney's declaration with respect to statements more appropriately made by appellant.

Appellant also filed that following declaration:

I, KENNETH W. DEBAUN, declare as follows:

1. I am the inventor and applicant of the invention entitled "FLUID VELOCITY EQUALIZING APPARATUS", disclosed and claimed in U.S. Application Serial No. 952,695 filed October 19, 1978.

2. The invention described and claimed in said application was conceived by me prior to June 1, 1973, as evidenced by the following facts which are of my own knowledge:

(a) Attached hereto[ <sup>5</sup> ] as an exhibit is a drawing No. 73-315, dated 3-15-73, which illustrates a velocity profile development of an apparatus having open-ended honeycomb velocity equalizing sections as originally conceived by me; that in accordance with my conception, the drawing shows an open-ended honeycomb equalizing section substantially coaxial with a fluid duct, said honeycomb sections having a plurality of parallel passages across substantially the en

#### Page 935

tire duct cross section, the ratio of surface area of each passage to the cross-sectional area of each passage at least 30, the end of the honeycomb facing the stream of fluid being curved to flatten the velocity profile of the stream. In addition, the length of the parallel passages, as shown, vary over the cross-sectional area of said conduit to equalize the fluid flow velocities across the cross-sectional area of the conduit;

<sup>5</sup> We do not consider it necessary to include drawing No. 73-315.

(b) Drawing No. 73-315 was given to patent counsel for purposes of preparing a patent application on an isokinetic sampling system of which I am coinventor with Robert W. Noll, said application having been filed on June 1, 1973, and resulted in U.S. Patent No. 3,842,678, issued October 22, 1974.

(c) Insofar as the invention of my pending application Serial No. 952,695 is suggested by drawing No. 73-315, or by anything contained in U.S. Patent No. 3,842,678, it was originally conceived by me and described to patent counsel prior to June 1, 1973.

3. That my invention as covered by claims of U.S. Application Serial No. 952,695 was described in the specification of U.S. Patent No. 3,842,678 merely to comply with the requirements of 35 USC §112, under the advise [sic] of applicant's attorneys.

The examiner maintained the rejection, concluding that appellant's declaration was insufficient under Rule 131 to overcome the reference.

The board sustained the §103 rejection. While agreeing with appellant that Noll's disclaimer should not be required, the board concluded:

we do not find that the declarations are sufficient to show that the appellant is solely the inventor of the subject matter claimed by this application.

On rehearing, the board rephrased its conclusion:

We are still of the opinion that the declaration on file are not sufficient to show that the appellant is the inventor of the subject matter claimed by this application as necessary to overcome a Section 103 rejection based upon the earlier patent.

## Opinion

### I .

[ 1 ] We agree with the examiner and the board that appellant could overcome, or "antedate," the '678 patent with a proper Rule 131 declaration. In re Facius, 56 CCPA 1348, 1355, 408 F.2d 1396, 1404, 161 USPQ 294, 300 (1969). We also agree that the declarations herein are insufficient under Rule 131 as they fail to allege facts showing the necessary diligence and/or reduction to practice of the invention now claimed. <sup>6</sup> See In re Harry, 51 CCPA 1541, 333 F.2d 920, 142 USPQ 164 (1964). However, the examiner erred in concluding that a Rule 131 affidavit is the only way of overcoming the rejection made in this case. See, e.g., In re Land, 54 CCPA 806, 825, 368 F.2d 866, 879-80, 151 USPQ 621, 633 n. 11 (1966).

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<sup>6</sup> Appellant has stated that he is unable to submit a declaration complying with the requirements of Rule 131.

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In In re Katz, Appeal No. 82-521, issued concurrently, we have *reaffirmed* that an applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application.

[ 2 ] Thus, the '678 patent to applicant and Noll, having issued less than one year before the filing date of appellant's original '519 patent application, is only available as a reference if the pertinent disclosure is not the sole work of appellant. As in Katz, *supra*, the specific issue raised by this appeal is an evidentiary one.

### II .

While the board recognized that the declarations filed herein under Rule 132 <sup>7</sup> must be considered, see Facius, 56 CCPA *supra* at 1352, 408 F.2d at 1402, 161 USPQ at 297 n.4, the board did not, in our view, focus on the significant question.

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<sup>7</sup> Rule 132, 37 CFR 1.132 provides:

When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication \* \* \* affidavits or declarations traversing these references \* \* \* may be received.

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[ 3 ] The board tested the declarations to determine whether they supported appellant's assertion of inventorship of the *improved* equalizer honeycomb section here claimed. That was error.

[T]he proper subject of inquiry was \* \* \* what the *evidence* showed as *who* invented the subject matter disclosed by [the reference] which was relied on to support the rejection. [In re Land, 54 CCPA at 825, 368 F.2d at 879-80, 151 USPQ at 633 n.11 (emphasis in original).]

The only question raised by the rejection is whether appellant invented the relevant disclosure in the '678 patent.

Page 936

### III .

[ 4 ] The '678 patent is silent with respect to who invented the basic equalizer honeycomb section itself, and we do not presume that it is the invention of appellant and Noll jointly or of either of them.

[T]he existence of combination claims does *not* evidence inventorship by the patentee of the individual elements or sub-combinations thereof if the latter are not separately claimed apart from the combination. It is clear that the inventor of a combination may not have invented *any* element of that combination, much less each of the elements. [In re Facius, *supra* at 1358, 408 F.2d at 1406, 161 USPQ at 301].

As in Katz, *supra*, the question of whether appellant is the sole inventor was properly raised by the PTO, and it was incumbent on appellant to provide satisfactory evidence, in light of the total circumstances of the case, that the reference reflected his own work. In re Facius, *supra*; In re Land, *supra*.

In Facius, the court concluded that the affidavits filed there did not sufficiently support Facius's contentions that he invented subject matter disclosed in the reference patent issued to another sole inventor, noting that the affidavits did not contain any statement that Facius was the *inventor* of such subject matter. In contrast, appellant's declaration here states that he originally "conceived" that basic equalizer honeycomb section disclosed in the '678 patent and in drawing No. 73-315.

[ 5 ] Although the law is well settled that a completed invention requires both conception and reduction to practice, there is no requirement that the inventor be the one to reduce the invention to practice so long as

the reduction to practice was done on his behalf. *Litchfield v. Eigen*, 535 F.2d 72, 76, 190 USPO 113, 116 (CCPA 1976). The filing by appellant and Noll of the application for the '678 patent was a constructive reduction to practice of the air sampling system including the passageway which contained the basis equalizer honeycomb section, which inures to appellant's benefit as one of the named inventors in the '678 patent. The question, then, is whether what was constructively reduced to practice was appellant's own conception. On the basis of the record here, which includes appellant's unequivocal declaration that he conceived anything in the '678 patent disclosure which suggests the invention claimed in his present application, that question has been satisfactorily answered.

We conclude that the board erred in upholding the rejection based on the '678 patent in view of appellant's showing that the basic equalizer honeycomb section is appellant's own invention.

*Reversed .*

## Concurring Opinion Text

### Concurrence By:

Miller, Judge, concurring.

I agree with the majority's holding that Noll's disclaimer is unnecessary; also, with its statement that we do not presume that the equalizer honeycomb section is the invention of appellant and Noll jointly or of either of them in light of the quoted language from *In re Facius*. Appellant's declaration sets forth his conception on or before March 15, 1973, well before the filing date of the DeBaun and Noll '678 patent, and other facts supported by exhibits which justify a conclusion that DeBaun was the sole inventor of the subject matter claimed in the present application. Thus, this case is readily distinguished from the facts in *In re Katz*, No. 82-521 (CCPA August 27, 1982), wherein I have filed my dissent. See *In re Land*, 54 CCPA 806, 823, 368 F.2d 866, 878, 151 USPQ 621, 632 (1966).

- End of Case -

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